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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,322	03/29/2004	Christina Kabbash	45775-Z/JPW/AJM/DNS	5097
7590	11/02/2005		EXAMINER	
John P. White Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	
DATE MAILED: 11/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,322	<b>Applicant(s)</b> KABBASH ET AL.	
	<b>Examiner</b> D. L. Jones	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 60-75 and 78-82 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 60-75 is/are allowed.  
6) ☒ Claim(s) 1-12 and 78-82 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1618

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 8/15/05 wherein and abstract was submitted; claims 1-6, 67, and 78 were amended; and claims 13-59, 76, and 77 are canceled.

**Note:** Claims 1-12, 60-75, and 78-82 are pending.

## **RESPONSE TO APPLICANT'S ARGUMENTS**

2. The Applicant's arguments filed 8/15/05 to the rejection of claims 1-12, 60, and 65-82 made by the Examiner under 35 USC 102 and/or 112 have been fully considered and deemed persuasive for the reasons set forth below. Therefore, the said rejections are hereby withdrawn.

### **112 First Paragraph Rejections**

The 112, first paragraph, rejections are WITHDRAWN for reasons of record in Applicant's response.

### **112 Second Paragraph Rejections**

The 112, second paragraph, rejections are WITHDRAWN because Applicant has amended/canceled the respective claim(s).

**Note:** It should be noted that the rejection of claims 1-12 as it relates to the variable X is WITHDRAWN because Applicant has amended the claims to delete the variable X.

Art Unit: 1618

**102 Rejections**

The 102 rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

**NEW GROUNDS OF REJECTIONS**

**New Matter Rejections**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 and 78-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

I. Claims 1-12: The claims have been amended to replace  $(CH_2)_pX(R_7)_2$  with  $(CH_2)_p(R_7)_2$  and  $(CH_2)_pXR_7COR_8$  with  $(CH_2)_pR_7COR_8$  (see lines 8-9). Likewise,  $(CH_2)_pX(CH_2)$  with  $(CH_2)_p(CH_2)$  and  $(CH_2)_pXCOH$  with  $(CH_2)_pCOH$  (see lines 17-18). However, Applicant has not point out where support for the claim as now amended may be found. In addition, search of the specification does not disclose support for where R1, R2, R3, R4, R5, and R6 is  $(CH_2)_p(R_7)_2$  or  $(CH_2)_pR_7COR_8$ .

II. Claims 1-12: The claims have been amended to incorporate the phrase 'wherein the linkage to the benzene ring by R1, R2, R3, R4, and R5 is independently

Art Unit: 1618

selected from the group consisting of N, S, O, and C'. Initially, the claims contained a broad disclosure that phrase 'wherein a linkage to the benzene ring may alternatively be N, S, O, or C'. Now, the claims have been amended to 'wherein the linkage to the benzene ring by R1, R2, R3, R4, and R5 is independently selected from the group consisting of N, S, O, and C''. Also, it is noted that the amended claim excludes a linkage between R6 and the benzene ring. In particular, the amendment to the claims now require that there be a linkage to the benzene ring by R1, R2, R3, R4, or R5. However, the compounds present in the specification, in particular, gemfibrozil, does not contain a linkage to R1, R2, R3, R4, or R5.

III. Claims 78-82: The claims have been amended to a method of determining whether or not a bacterium is sensitive to gemfibrozil having the steps of independent claim 78. In particular, the specification does not disclose that a specific *Legionella pneumophila* concentration is determined and used to determine whether the other bacterial is sensitive to gemfibrozil. Instead, Example 1, pages 17-25, disclose that the minimum gemfibrozil concentration at which no growth occurred was 10 mg/ml, but the concentrations of gemfibrozil used for the other bacteria is different. Thus, the step of contacting the bacterium with a concentration of gemfibrozil known to inhibit the growth of *Legionella pneumophila* was not consistent with that which had been determined in Example 1.

### **112 Second Paragraph Rejections**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1618

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-12: The claims as written are ambiguous because of the phrase 'wherein the linkage to the benzene ring by R1, R2, R3, R4, and R5 is independently selected from the group consisting of N, S, O, and C'. In particular, when the linkage is by C (carbon) is that linkage by CH<sub>2</sub> or by some other carbon containing group?

#### **ALLOWABLE CLAIMS**

7. Claims 60-75 are allowable over the prior art of record for reasons of record in the office action mailed 5/12/05.

#### **COMMENTS/NOTES**

8. It is duly noted that whenever A is a C1-C10 alkyl (see independent claim 1), then Q is 1 (this interpretation is consistent with Applicant's specification). For example, when A is (CH<sub>2</sub>)<sub>3</sub>, then Q is 1.

9. It should be noted that the amended claims are free of the art of record. However, Applicant MUST address and overcome the 112 rejections above.

Art Unit: 1618

10. Applicant is respectfully requested to replace 'comprises' with proper Markush terminology (see MPEP 803.02) in claim 1, line 27.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 1618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones  
Primary Examiner  
Art Unit 1618

October 31, 2005